



10-01-04

1626
Bjw

146.1376

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
A. CORBIER et al
Serial No.: 10/009,407
Filed: December 5, 2001
For: NEW...AS ANTIFUNGALS

: R. SHIAO
: Group: 1626
:
475 Park Avenue South
New York, N.Y. 10016
September 30, 2004

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the office action of July 8, 2004, Applicants request reconsideration of the application in view of the remarks presented herein.

The claims in the application are claims 1 to 23, no other claims having been presented.

The Examiner has required a four way restriction requirement depending upon the definition of the R variable. The Examiner has set the four groups out in the office action and indicated that restriction was proper and that an election of species should be made. The Examiner indicates that the compounds defined in the claims lack the significant structural element qualifying as a special technical feature that defines the contribution over the prior art. The Examiner states that the compound contains a pyrrolidine moiety which does not define a contribution over the prior art as can be seen by the compounds

10/05/2004 RFEKADU 00000046 10009407

01-FG:1252

420.00-OP

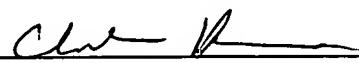
of published U.S. patent application No. 2003/147897. The Examiner states that the substituents on the pyrrolidine moiety vary extensively and result in different compounds.

Applicant vigorously traverse this restriction requirement since it is deemed that the compounds are not patentably distinct and that the Examiner has not demonstrated that there is a lack of unity of invention wherein the Examiner must list the different groups of claims and explain why each group lacks unity with the other members of the groups such that there is no general inventive concept specifically describing the unique special feature in each group as stated in the MPEP 1893(d). The Examiner has failed to specifically describe the unique special feature in each group. It should be noted that the compounds as set out by the Examiner in the variable R do not all contain pyrrolidine as alleged by the Examiner but are directed to different groups. Therefore, it is deemed that the restriction requirement is not proper and that there is but a single invention present.

It should be noted that all of the compounds have the same utility, namely, they all possess antifungal activity. However, in order to be fully responsive to the Examiner's restriction requirement, Applicants elect group I with traverse and request that the Examiner reconsider the restriction requirement. With respect to the election of a single species, Applicants elect the compound of Example 1 with traverse.

Since the first office action was merely a restriction requirement, Applicants request a prompt examination on the merits.

Respectfully submitted,
Muserlian, Lucas and Mercanti


Charles A. Muserlian, 19,683
Attorney for Applicants
Tel.# (212) 661-8000

CAM:ds
Enclosures